

### **REMARKS**

In response to the Non-Office Action mailed April 14, 2008 (hereinafter "Office Action"), claims 1, 36, 71, 102, 133 and 153 have been amended and claim 135 has been cancelled without prejudice or disclaimer. No claims have been newly added. Support for the instant amendments is provided throughout the embodiments disclosed in the originally filed Specification. Thus, no new matter has been added. Therefore, claims 1-134 and 136-153 are pending, of which claims 11-13, 17-22, 48, 52-57, 82-83, 99, 101, 113-114, 130 and 132 remain withdrawn.

In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

#### **Rejections under 35 U.S.C. § 103**

- Claims 1-10, 14-16, 23-45, 49-51, 58-81, 84-98, 100, 102-112, 115-129, 131, 133-134 and 136-146 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,803,500 to Mossberg ("Mossberg") in view of U.S. Patent No. 6,012,045 to Barzilai ("Barzilai"), U.S. Patent No. 6,255,652 to Godin *et al.* ("Godin") and U.S. Patent No. 5,903,874 to Leonard *et al.* ("Leonard").
- Claims 135 and 147-148 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mossberg in view of Godin and Leonard and further in view of the Official Notice taken ("Official Notice").
- Claims 149-153 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mossberg in view of Barzilai, Godin and Leonard and further in view U.S. Patent No. 6,112,181 to Shear ("Shear").

Applicants disagree with the propriety of these rejections. However, solely in an effort to expedite prosecution, Applicants have amended independent claims 1, 36, 71, 102, 133 and 153 to clarify some of the differences and to broaden some aspects of the claimed invention.

Previously, Applicants addressed the rejection of independent claim 133 first, and thus, Applicants will again begin discussion with regard to the rejection of independent claim 133.

**A. The alleged combination of Mossberg, Barzilai, Godin, and Leonard fails to teach or otherwise render obvious all the features of independent claim 133.**

Assuming, *arguendo*, that it were legally proper to modify Mossberg based on teachings of Barzilai, Godin, Leonard (which Applicants do not concede), the combination thereof fails to disclose or otherwise render obvious each and every feature recited in independent claim 133.

**I. The combination of Mossberg, Barzilai, Godin and Leonard fails to disclose or otherwise render obvious enabling one or more of the restaurants to post on the web site a listing of one or more discounted gift certificates being offered for sale wherein the one or more restaurants provide, at the time of the post, valid dates and times for use of the one or more discounted gift certificates to reduce excess capacity during the non-peak demand period.**

Independent claim 133 recites, *inter alia*, the features of:

enabling one or more of the restaurants to post on the web site a listing of one or more discounted gift certificates being offered for sale wherein the one or more restaurants provide, at the time of the post, valid dates and times for use of the one or more discounted gift certificates for reducing excess capacity during the non-peak demand period.

Mossberg, Barzilai, Godin, and Leonard, either taken alone or in combination, fail to disclose, teach or suggest at least these features. For example, the Examiner *concedes* that Mossberg is silent with regard to whether "... the discounted gift certificates are redeemable for service from a corresponding one of the one or more restaurants during the non-peak demand periods." [Office Action, page 4]. Barzilai and Godin are silent as to this feature also.

The Examiner, however, alleges that "Leonard discloses a coupon that provides a discount from a predetermined price during non-peak hours (Leonard, see col. 5, lines 47-60); Examiner interprets a coupons to be analogous to a certificate." [Office Action, pg. 7]. While

Leonard may disclose controlling the availability of a coupon to be used [see, e.g., col. 5, lines 47-62], Leonard provides no indication or suggestion whether businesses and/or restaurants can post on a web site the discounted gift certificates for sale, much less that "... one or more restaurants provide, at the time of the post, valid dates and times for use of the one or more discounted gift certificates to reduce excess capacity during the non-peak demand period for reducing excess capacity."

Moreover, the Examiner *concedes* that "... the combination [of Mossberg, Barzilai, Godin and Leonard] is silent with respect to the validity of reducing capacity during peak hours." [Office Action, pages 8-9]. The Examiner, however, takes Official Notice to the fact "... that businesses have non-peak demand periods and only except (*sic*) coupons during the non-peak demand periods in order to reduce capacity during peak time in which full price is required. This helps increase revenues during peak-times." [Office Action, page 9]. Applicants respectfully traverse the Official Notice taken for at least the following reasons.

It is inappropriate to rely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1385, 1697 (Fed. Cir. 2001). Indeed, the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). Notwithstanding that the Official Notice taken is unsupported by facts on the record, it does not teach that "... the one or more restaurants provide, at the time of the post, valid dates and times for use of the one or more discounted gift certificates to reduce excess capacity during the non-peak demand period."

In contrast to the relied-upon references and the alleged Official Notice taken, one advantage of the claimed invention is that businesses and restaurants can target and/or control the sale of discounted gift certificates to reduce excess capacity during non-peak demand periods to customers who actually want to bid or purchase the discounted gift certificates. As disclosed in Applicants' Specification, broad advertising to the public has generally been

ineffective. [See, e.g., page 24, lines 16-19]. Moreover, web-based auctions have not enabled businesses and restaurants to provide, at the time of the post, valid dates and times for use of the one or more discounted gift certificates to reduce excess capacity during the non-peak demand period.

For *at least* the foregoing reasons, the rejection of independent claim 133 is improper and should be withdrawn.

II. The combination of Mossberg, Barzilai, Godin and Leonard fails to disclose or otherwise render obvious displaying options to enable users to place a bid on one or more discounted gift certificates for auction and being determined a winner, or to purchase the one or more discounted gift certificates at a fixed price independent of the auction via an instant purchase feature without participating in the auction.

Independent claim 133 recites, *inter alia*, the features of:

displaying options to enable users to place a bid on one or more discounted gift certificates for auction and being determined a winner, or to purchase the one or more discounted gift certificates at a fixed price independent of the auction via an instant purchase feature without participating in the auction.

Mossberg, Barzilai, Godin, and Leonard, either taken alone or in combination, fail to disclose, teach or suggest at least these features. For example, as *conceded* by the Examiner, Mossberg fails to teach an instant purchase feature. [See Office Action, pg. 4]. Barzilai and Leonard are silent regarding an instant purchase feature also.

The Examiner, however, alleges that Godin teaches an instant purchase feature. Claim 133 (as amended) recites “displaying options to enable users ... to purchase the one or more discounted gift certificates at a fixed price ***independent of the auction*** via an instant purchase feature without participating in the auction.” Godin fails to teach this feature. Rather, Godin teaches a reverse auction where the price associated with the “Buy Now” features changes as the auction continues. [See, e.g., Godin, col. 4, lines 45-56; FIG. 10; Cf. col. 1, lines 22-24]. As such, Godin *teaches away* from claimed invention, as the “Buy Now” price is *reliant* on the

auction in progress. Indeed, "... when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." See *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1395 (2007) (citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966)).

For at least the foregoing reasons, the rejection of independent claim 133 under 35 U.S.C. § 103(a) over Mossberg in view of Barzilai, Godin and Leonard is improper and should be withdrawn. Dependent claims 134 and 136-152 are allowable because they depend from the allowable independent claim 133, as well as for the additional features they recite individually. Claim 135 has been cancelled and thus, the rejection thereof is moot.

Moreover, Shear does not overcome the deficiencies of Mossberg, Barzilai, Godin, and Leonard. For example, Shear was relied upon by the Examiner for allegedly teaching a restaurant search module. [See Office Action, page 11].

**B. The alleged combination of Mossberg, Barzilai, Godin, and Leonard and further in view of Shear fails to teach or otherwise render obvious all the features of independent claim 153.**

Assuming, *arguendo*, that it were legally proper to further modify the combination of Mossberg, Barzilai, Godin, and Leonard, based on the teachings of Shear (which Applicants do not concede), the combination of Mossberg, Barzilai, Godin, Leonard, and Shear fails to disclose or otherwise render obvious each and every feature recited in independent claim 153.

Independent claim 153 recites, *inter alia*, the features of:

a restaurant listing module, the listing module providing restaurants the ability to post a listing offering discounted gift certificates for sale according to a cuisine type, zip code, or geographic area parameter, wherein the restaurants provide at the time of posting a listing, valid dates and time for using the discounted gift certificates to reduce excess capacity during the non-peak demand periods; and

an instant purchase feature that enables the user to immediately buy one or more of the discounted gift certificates at a fixed price specified by a corresponding one of the restaurants

that is independent of the auction without participating in the auction.

As discussed above, the combination of Mossberg, Barzilai, Godin, and Leonard fails to disclose, teach, or suggest "providing restaurants the ability to post a listing offering discounted gift certificates for sale ... wherein the restaurants provide at the time of posting a listing, valid dates and time for using the discounted gift certificates to reduce excess capacity during the non-peak demand periods."

Furthermore, for similar reasons as discussed above, the combination of Mossberg, Barzilai, Godin, and Leonard also fails to disclose, teach, or suggest "enabl[ing] the user to immediately buy one or more of the discounted gift certificates at a fixed price specified by a corresponding one of the restaurants that is independent of the auction without participating in the auction."

Shear does overcome the deficiencies of Mossberg, Barzilai, Godin, and Leonard either. For example, Shear was relied upon by the Examiner to allegedly teach a restaurant search module. [See Final Action, pg. 16].

For *at least* the foregoing reasons, the rejection of independent 153 under 35 U.S.C. § 103(a) over Mossberg, Barzilai, Godin, Leonard and further in view of Shear is improper and should be withdrawn.

**C. The alleged combination of Mossberg, Barzilai, Godin, and Leonard fails to teach or otherwise render obvious all the features of independent claims 1 and 36.**

Independent claim 1 recites, *inter alia*, the features of:

enabling one or more businesses to post on the web-site one or more items for auction wherein the one or more businesses provide, at the time of the post, valid dates and times for use of the one or more items to reduce excess capacity during the non-peak demand period; and

displaying options to enable users to place a bid on an item for auction or to purchase the item at a fixed price independent of the auction without participating in the auction.

Similarly, independent claim 36 recites:

a business module for enabling one or more businesses to post on the web-site one or more items for auction wherein the one or more businesses provide, valid dates and times for use of the one or more items to reduce excess capacity during the non-peak demand period; and

a user module for displaying options to enable users to place a bid on an item for auction or to purchase the item at a fixed price independent of the auction without participating in the auction.

As discussed above, the combination of Mossberg, Barzilai, Godin, and Leonard fails to disclose, teach, or suggest "enabling one or more businesses to post on the web-site one or more items for auction wherein the one or more businesses provide, valid dates and times for use of the one or more items to reduce excess capacity during the non-peak demand period."

Furthermore, for similar reasons as discussed above, the combination of Mossberg, Barzilai, Godin, and Leonard also fails to disclose, teach, or suggest "displaying options to enable users to place a bid on an item for auction or to purchase the item at a fixed price independent of the auction without participating in the auction."

For *at least* the foregoing reasons, the rejection of independent claims 1 and 36 under 35 U.S.C. § 103(a) in view of Mossberg, Barzilai, Godin, and Leonard is improper and should be withdrawn. Dependent claims 2-10, 14-16, 23-35, 37-47, 49-51, 58-70, are allowable because they depend from the allowable independent claims 1 and 36, as well as for the additional features they recite individually.

**D. The alleged combination of Mossberg, Barzilai, Godin, and Leonard fails to teach or otherwise render obvious all the features of independent claims 71 and 102.**

Independent claim 71 recites, *inter alia*, the features of:

providing a web site to which one or more businesses can post an offer to auction one or more certificates for use during non-peak demand periods, the one or more certificates having a

predetermined value and being redeemable for services from a corresponding one of the one or more businesses, wherein the one or more businesses provide at the time of the post, valid dates and times, for use of the one or more certificates to reduce excess capacity during the non-peak demand periods; and displaying options to enable users to place a bid on a certificate for auction or to purchase the certificate at a fixed price independent of the auction without participating in the auction.

Similarly, independent claim 102 recites:

a web site to which a business can post an offer to auction one or more certificates for use during non-peak demand periods to reduce unused capacity, the one or more certificates having a predetermined value and being redeemable for services from the business, wherein the business provides at the time of the post, valid dates and times, for use of the one or more certificates to reduce excess capacity during the non-peak demand period; and a user module for displaying options to enable users to place a bid on a certificate for auction or to purchase the certificate at a fixed price independent of the auction without participating in the auction.

As discussed above, the combination of Mossberg, Barzilai, Godin, and Leonard fails to disclose, teach, or suggest a web site to which a business can post an offer to auction one or more certificates for use during non-peak demand periods to reduce unused capacity ... wherein the business provides at the time of the post, valid dates and times, for use of the one or more certificates to reduce excess capacity during the non-peak demand period.

Furthermore, for similar reasons as discussed above, the combination of Mossberg, Barzilai, Godin, and Leonard also fails to disclose, teach or suggest displaying options to enable users to place a bid on a certificate for auction or to purchase the certificate at a fixed price independent of the auction without participating in the auction.

For *at least* the foregoing reasons, the rejection of independent claims 71 and 102 under 35 U.S.C. § 103(a) in view of Mossberg, Barzilai, Godin, and Leonard is improper and should be withdrawn. Dependent claims 72-81, 84-98, 100, 103-112, 115-129, and 131, are



allowable because they depend from the allowable independent claims 71 and 102, as well as for the additional features they recite individually.

### **CONCLUSION**

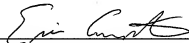
Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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